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EXAMINER

MARSCHEL, ARDIN H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1631

DATE MAILED: 07/09/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,928

Applicant(s)

FODOR ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 57-155 is/are pending in the application.
- 4a) Of the above claim(s) 156-158 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 57-155 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) 57-158 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 23 & 24
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 19 & 20
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicants' arguments, filed 4/23/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Non-elected by original presentation

Newly submitted claims 156-158 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions of claims 57-155 and of claims 156-158 are related as apparatus, media, or products and product made, respectively. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, claims 157-155 as originally presented are directed to computer readable media, computer software products, and systems which in turn are directed to scanning an array in order to acquire data therefrom. The image files of claims 156-158 may be produced thereby but also can be made by another and materially different apparatus, such as a photographic type of imaging apparatus or system which then processes the data to produce an image file without scanning performed.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 156-158 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

NEW MATTER

Claims 102-107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 102 has been amended to add the limitation in the last 2 lines directed to the phrase "collecting intensity data from less than ½ of each...". The "less than ½" collection of intensity data over each localized area has not been found as to written basis as filed. Therefore this is NEW MATTER in claim 102 and claims directly or indirectly dependent therefrom. This rejection is necessitated by amendment.

Vagueness and Indefiniteness

Claims 57-155 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained and reiterated from the previous office action, mailed 1/10/03, and as also necessitated by amendment. This rejection is based on unclarity

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as to the actual method steps being executed being not clearly distinguished for array scanning versus a generic scanner of a substrate surface area. It is noted that claim 57, for example, has been amended in the last line to indicate that pixel data is collected "to generate an average intensity...". The "to generate" limitation is not worded in claim 57 to actually require such generation as an executed computer instruction. Rather, the last step of claim 57 is directed to "collecting pixel data" and there is no separate step wherein generation of average intensity is performed. Therefore a reasonable interpretation of this last step in claim 57 is that it ends with the collection of pixel data and the intended use of generation of average intensity may or may not occur sometime, but not necessarily within the actual executable instructions on the claimed computer readable medium per se. This added wording directed to generation of average intensity is amended into claim 57 and therefore is a new issue that necessitated the above added discussion regarding the basis for this rejection. Clarification of the metes and bounds of claim 57 is requested via clearer claim wording as to whether there is some array scanning specificity in the executable instructions stored on the medium as in the preamble of the claim or whether generic scanner control instructions would accomplish the steps in claim 57 as apparently they would. The unclarity is also present in independent claims 65, 73, 78, 86, 94, 102, 108, 120, 132, and 144. Claims dependent either directly or indirectly from claims 57, 65, 73, 78, 86, 94, 102, 108, 120, 132, and 144 are included in this rejection due to their dependence.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 57-155 are rejected under 35 U.S.C. 102(b)(both references) and (e)(2)(Tomei et al., only) as being clearly anticipated by either of Williams et al.(1985) or Tomei et al.(P/N 4,758,727).

Both Williams et al. (results depicted in Figures 1 and 2) and Tomei et al. (results depicted in Figure 2 and related discussion, especially also the SUMMARY OF THE INVENTION section in columns 2-3) scan a surface, receive pixel data which is collected. The citation of these references does not prevent the below summarized finality because they have been newly supplied without a certification under 37 CFR § 1.97(e). It is noted that the above discussion regarding claim wording interpretation under 35 U.S.C. § 112, second paragraph, supports the claim interpretation that average intensity generation is not a required computer media, software, or system limitation to anticipate the instant claims. Such average intensity generation is also noted as not being disclosed in the reference as directed to such an averaging over each localized area on an array surface.

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No claim is allowed.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Completeness of Reply

This application contains claims 156-158, drawn to an invention nonelected by original presentation. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is

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(703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

July 7, 2003

Adrian H. Marschall
Adrian H. Marschall
Examiner